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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,025	11/03/2000	William E. Bollinger	10	4973
7590	02/26/2004		EXAMINER	JAGANNATHAN, MELANIE
Thomas R Fitzsimons Insors Integrated Communications 111 W Jackson Blvd Suite 1412 Chicago, IL 60604			ART UNIT	PAPER NUMBER
			2666	
			DATE MAILED: 02/26/2004	2

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	09/706,025	
Examiner	BOLLINGER ET AL.	
Melanie Jagannathan	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 03 November 2000.  
2a) This action is FINAL.                    2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) 12 and 22 is/are allowed.  
6) Claim(s) 1,11,13,14 and 21 is/are rejected.  
7) Claim(s) 2-10 and 15-20,23,24 is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on 03 November 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claims 3, 23-24 are objected to because of the following informalities: in claim 3, line 9, claim 23, line 52, and claim 24, line 56, sentence should end with semi-colon instead of period. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11, 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed limitation of claim 11, starting on line 9 and ending on line 16, and of claim 21, starting on line 5 and ending on line 12, "using said termination number to determine...desired route is over the PSTN" is not disclosed in the specification. An "or"

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condition between steps (3) and (4) of claims 11 and 21 is disclosed in specification, which is absent from claimed limitation. Thus, one of ordinary skill in the art cannot unambiguously derive the claimed limitation, from that disclosed, without undue experimentation.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of disconnecting PBX from PSTN does not functionally interconnect with limitations of claim regarding programming gateway to determine desired route for incoming and outgoing calls over PSTN, over PBX or over data network.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1,13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al. US 6,574,216. The claimed gateway connected to a PBX, the gateway connected to data network, the PBX connected to PSTN is disclosed by SSP (Figure 3, elements 13, 17) connected to internet modules (elements 92 and 94), internet modules connected to Internet (element 50), the SSPs connected to PSTN (element 10). Also see column 8, lines 16-65. The claimed programming gateway to receive and determine desired route for all incoming and outgoing calls if desired route is over PSTN or over PBX and to detect if desired route is available over data network and to transmit over data network and to redirect transmission over PSTN if desired route is not available is disclosed by voice call being placed and if dialing information indicates that the call is to be routed through the Internet, a quality check is made and if monitored performance level is found to be unsatisfactory, the call is routed through the PSTN. See Figure 6 and column 9, lines 35-67 and column 10, lines 1-24.

Farris et al. disclose all of the limitations except for disconnecting PBX from the PSTN. At the time the invention was made it would have been obvious to a person of ordinary skill in the art to modify Farris et al. to disconnect PBX when call is routed through data network. One of ordinary skill in the art would be motivated to do this since the use of data network reduces toll rates for long distance calls charged by use of long distance interexchange carriers or PBXs. See column 3, lines 35-42.

***Allowable Subject Matter***

9. Claims 2, 4-10, 15-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 3, 23-24 would be allowable if appropriate corrections are made to minor informalities of the claims.

10. Claims 12, and 22 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:  
Prior art of record does not disclose, in single or in combination, dial plan using termination number to determine if call is intra-company call, leaking call from data network or from PBX, developing national enterprise list, national leak list, international outbound enterprise list, international outbound leak list, international inbound list, special list in combination with limitations regarding programming of gateway to transmit call over desired route and to detect if route over data network is available and if unavailable routing over PSTN.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hsu US 5,661,790 discloses call back service for a regulatory restrictive area.

Oran US 6,275,574 discloses dial plan mapper.

Wellard et al. US 6,510,219 disclose alternate network fallback for IP telephony.

Ward et al. US 6,556,565 disclose Internet protocol telecommunication with quality of service server.

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Cruickshank US 6,389,005 discloses automatic backup trunking for voice over the Internet.

Belzile US 6,253,249 discloses method and devices for bridging data and telephone networks.

Goeddel et al. US 6,141,345 disclose signal processing resource allocation for internet-based telephony.

White et al. US 5,933,490 disclose overload protection for on-demand access to the Internet that redirects calls from overloaded Internet service provider to alternate access provider.

McKinnon et al. US 6,175,565 disclose serial telephone adapter.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Jagannathan whose telephone number is 703-305-8078. The examiner can normally be reached on Monday-Friday from 8:00 a.m.-4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 703-308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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